

**REMARKS**

**I. Status of the Claims**

Claims 1-108 are pending in this application. No claim has been amended in this Reply.

**II. Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has maintained the rejection of claim 12 under 35 U.S.C. § 112, second paragraph on the basis that the metes and bounds of the scope of the claim are unclear. Advisory Action at page 2 (emphasis added). Applicants again traverse this rejection.

Applicants submit that the scope of the claim when read properly in light of the specification is perfectly clear. In defining their claimed invention, Applicants have the latitude to be their own lexicographer. MPEP § 2173.01. A claim may not be rejected because of the type of language used to define the subject matter for which patent protection is sought. *Id.* Definiteness of claim language must be analyzed in light of, *inter alia*, the content of Applicants' disclosure. MPEP § 2173.02.

In the present case, Applicants' specification defines the phrase "essentially non-crosslinked" in a manner that would be clear to one skilled in the art. Specification at page 5, lines 5-7. One would know from the specification that a silicone copolymer having some crosslinking (not enough to fit into the category of being crosslinked and more than that needed to fit into the category of being non-crosslinked) are essentially non-crosslinked. As such, all such silicone copolymers that fit this definition are included in Applicants' claim. Therefore, the metes and bounds of the claim are clear.

The Examiner's reference to a standard for determining how much crosslinking must occur for a copolymer to be considered essentially non-crosslinked<sup>1</sup> is not an issue that should be raised under § 112, second paragraph. While Applicants claims may be broad, they are not indefinite. Indeed, it is well-known that breadth is not to be equated with indefiniteness. MPEP § 2173.04. If the scope of the subject matter embraced by the claims is clear, and if Applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph. *Id.* For at least these reasons, withdrawal of this rejection is respectfully requested.

### III. Rejections Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejections, under 35 U.S.C. § 103(a), of the following:

(A) claims 1-31, 38-40, and 94-108 over European Patent No. EP 0874017 A2 to *Dalle et al.* ("*Dalle*") in view of U.S. Patent No. 5,650,383 to *Dubief et al.* ("*Dubief*"),

(B) claim 32 over the *Dalle/Dubief* combination in further view of U.S. Patent No. 5,063,051 to *Grollier et al.* ("*Grollier*"),

(C) claim 33 over the *Dalle/Dubief/Grollier* combination in further view of U.S. Patent No. 4,957,732 to *Grollier et al.* ("*Grollier '732*"),

---

<sup>1</sup> The basis of Applicants' argument herein is that the Examiner inadvertently omitted the word *essentially* before the phrase *non-crosslinked copolymer* in the final Office Action at page 2, third paragraph, last sentence of the § 112, second paragraph rejection because no standard would be needed to determine how much crosslinking there is in a non-crosslinked copolymer. There is no crosslinking in a non-crosslinked polymer.

(D) claims 34-37 over the *Dalle/Dubief/Grollier/Grollier '732* combination in further view of U.S. Patent No. 6,011,126 to *Dubief et al.* ("*Dubief '126*"),

(E) claims 41-67 over the *Dalle/Dubief/Grollier/Grollier '732/Dubief '126* combination in further view of U.S. Patent No. 6,039,936 to *Restle et al.* ("*Restle*"), and

(F) claims 68-93 over the *Dalle/Dubief/Grollier/Grollier '732/Dubief '126/Restle* combination in further view of U.S. Patent No. 5,948,739 to *Inman* ("*Inman*").

Applicants continue to traverse these rejections for at least the reasons of record and for the additional reasons set forth below.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing at least that there exists some suggestion or motivation to modify or combine reference teachings. M.P.E.P. § 2143. This showing must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Importantly, the Examiner must present a "full and reasoned explanation" of her decision, wherein the reasons supporting the decision are articulated and the decision is sound. *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). In the present case, the Examiner has failed to articulate a reason why one of skill in the art would be motivated to modify *Dalle* by adding the silicones of *Dubief*. The basis for the Examiner's combination of references is that it would have been obvious to modify the *Dalle* compositions by adding the polyorganosiloxanes of *Dubief*. Final Office Action at page 4. Applicants respectfully disagree.

*Dubief* is not directed only to silicones. The *Dubief* compositions are synergistic mixtures of a silicone in combination with a copolymer derived from diallyldialkylammonium and from an anionic monomer. Column 1, lines 30-34. The

synergistic mixture results in imparting to hair disentangling and softness properties superior to those two properties imparted by the silicone alone. Column 1, lines 35-39.

There would have been no motivation to destroy the synergism of Dubief by using only the silicone component of Dubief's compositions, as suggested by the Examiner. The benefits of Dubief's compositions referred to by the Examiner at page 2 of the Advisory Action are a function of the synergistic mixture and not of the individual components of the compositions. For this reason, Dubief would have taught away from the combination suggested by the Examiner. Absent the motivation to combine the references, there can be no prima facie case of obviousness. Withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN  
HENDERSON  
FARABOW  
CARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 9, 2002

By: 

Richard A. Schwartz  
Reg. No. 48,105

364368\_1

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com